

Amendments to the Drawings

Attached hereto is(are) four (4) replacement sheet(s) of corrected drawings that comply with the provisions of 37 C.F.R. § 1.84. The corrected drawings incorporate the following drawing changes:

Figs. 2-9 have been labeled as "Convention Art".

It is respectfully requested that the corrected drawings be approved and made a part of the record of the above-identified application.

Remarks

Claims 4-12, 22, and 24-35 are pending in the present application. By this reply, claim 23 and non-elected claims 1-3 and 13-21 have been cancelled. Claims 4, 9, 22, 28 and 29 are independent claims.

The specification and claims have been revised to clarify the invention and to improve form according to U.S. practice. These modifications do not add new matter to the disclosure.

Drawings

Figures 1-9 have been objected to because the Examiner states that they should be designated by a legend such as "Prior Art". To overcome this objection Figures 2-9 have been designated by a legend "Conventional Art" to illustrate that which is old as required by MPEP section 608.02(g). Figure 1 has not been labeled since the device of Figure 1 is used to implement the recording method of the present invention as stated on page 13, lines 15+ of the specification. Accordingly, reconsideration and withdraw of the drawing objection are requested.

Claim Objection

Claims 30-32 have been objected to because of minor informalities. Accordingly, these claims have been revised to improve grammar and to clarify the invention. Thus, the objection should be withdrawn.

35 U.S.C. § 102 Rejection

Claims 4-12, 22-33 and 35 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Takahashi (U.S. Patent No. 5,898,655). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

First, on page 4 of the Office Action, the Examiner states that “there is no patentable distinction between independent claims 22 and 28”. Applicants respectfully disagree. Previous claim 22 recited “a recording condition data including the optimal recording power, recorder identification, recording speed and write strategy”, whereas previous independent claim 28 recited “a recording condition data including the optimal recording power for the specific recording speed and write strategy for the specific recording speed”. As such, previous claim 22 is patentably distinct from previous claim 28 since it requires additionally the recorder identification and the recording speed. The same argument applies to presently amended claims 22 and 28.

Second, Takahashi is directed to storing a number of different test datas and a number of different corresponding power setting information within a power calibration area PCA of the recording medium 1 as shown

in Figures 1a and 1b. However, Takahashi does not disclose or suggest each and every recording condition data of the claimed invention. For example, Takahashi does not teach or suggest "recording speed and write strategy" as required by independent claim 22 or "recording power... and write strategy for the specific recording speed" as required by independent claim 28 or "information for managing the history of a recording environment variation occurring in association with the derived recording condition" as required by independent claim 4. The Examiner asserts that speed and strategy are inherent in Takahashi. However, Applicant finds no support for such inherency in Takahashi and therefore officially challenges the Examiner's assertion.

Furthermore, in Applicant's claimed invention, the history managing information/recording condition data are recorded in "a lead-in area or an area inner than the lead-in area" as required by claims 4, 22 and 28.

Therefore, Takahashi fails to anticipate the invention as set forth in independent claims 4, 22 and 28 and their dependent claims (due to their dependency), and the rejection should be withdrawn.

On pages 5 and 6 of the Office Action, the Examiner refers to Applicant's disclosed conventional art and/or Kim (U.S. Patent No. 6,646,965) to reject these claims. However, the Examiner's official rejection stands as a 102(b) rejection over Takahashi only since the Examiner did not officially present a rejection under 35 U.S.C. § 103

relying on these references. The Examiner is respectfully requested to withdraw such statements.

Claims 4-11 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Lee et al. (U.S. Patent No. 6,404,712).

Regarding independent claim 4, Lee et al. discloses that the detected optimal writing power is recorded in the test area A of the PCA of the recording medium. Therefore, Lee et al. does not anticipate, *inter alia*, "generating information for managing the history of a recording environment variation occurring in association with the derived recording condition, and recording the information onto an area of the optical recording medium, wherein the area of the optical recording medium is a lead-in area or an area inner than the lead-in area of the optical recording medium", as required by claim 4. Thus, the rejection has been overcome and should be withdrawn.

35 U.S.C. § 103 Rejection

Claim 34 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 28 above and further in view of Hamilton et al. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As discussed above, Takahashi does not teach each and every feature recited in independent claim 28 from which claim 34 depends. Further, Hamilton et al. does not overcome these deficiencies of Takahashi since Hamilton is relied on for providing country codes.

Therefore, the combination of references as applied by the Examiner does not render obvious the invention of claim 28 and claim 34 due to its dependency. Accordingly, the rejection is improper and should be withdrawn.

Claims 4-11, 22-26, 28-31 and 33 have been rejected under 35 U.S.C. § 103(c) as being obvious over Kim (U.S. Patent No. 6,646,965) in view of Takahashi. Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Takahashi and further view of Miyata. Claims 27, 32 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Takahashi and Applicant's disclosed conventional art including Figure 9. Claim 34 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Takahashi as applied to claim 28 and further in view of Hamilton et al.

Without acquiescing to any of the Examiner's allegations made in rejecting these claims, Applicant hereby states that Kim and the presently claimed invention were, at the time the invention was made, owned by the same assignee. More specifically, Kim is assigned to LG Electronics, Inc. as indicated on the first page of the patent. The presently claimed invention is also assigned to LG Electronics, Inc. (The Assignment has been properly recorded at the USPTO on September 18, 2000, Reel no. 011132, Frame no. 0795/0797). Thus, according to 35 U.S.C. § 103(c), Kim cannot be used to reject the present claims under

35 U.S.C. § 103(a). Accordingly, all these rejections should be withdrawn.

Double-Patenting Rejection

Claims 4, 5 and 7 have been rejected under the judicially created doctrine of double patenting over claims 1-4 of Lee et al. (U.S. Patent No. 6,404,712). Claims 22-24, 26 and 28-31 have been rejected under the judicially created doctrine of obviousness-type double patenting rejection as being unpatentable over claims 1-4 of Lee et al. (U.S. Patent No. 6,404,712) in view of Kim (U.S. Patent No. 6,646,965). Claim 25 has been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,404,712 (Lee et al.) with the additional teaching from Kuroda. Claims 27, 32 and 35 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,404,712 (Lee et al.) with the additional teaching from Applicant's disclosed background art. Claim 34 has been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,404,712 (Lee et al.) as noted for claim 28 with the additional teaching from Hamilton et al. These rejections, insofar as they pertain the presently pending claims, are respectfully traversed.

While not conceding the appropriateness of the Examiner's rejections, but merely to advance prosecution of the instant application,

Applicant herewith submit a Terminal Disclaimer disclaiming the terminal portion of any patent granted on the present application which would extend beyond the expiration of U.S. Patent No. 6,404,712. The filing of the Terminal Disclaimer is not and should not be in any way construed as an admission of the propriety of the rejection. MPEP § 804.02. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

Multiple Prior Art Rejections of the same Claim should be avoided

Prior art rejections should generally be confined strictly to the best available art. Merely cumulative rejections should be avoided. MPEP 706.02. In the present case, many claims were multiply-rejected.

Applicant respectfully submits that such practice places serious and undue burden on the Applicant to fully and adequately address all of the multiple prior art rejections of the claims. The Examiner is respectfully requested to refrain from making such multiple prior art rejections of the same claims in the future as recommended by MPEP 706.02. The Examiner's cooperation would be greatly appreciated.

Conclusion

For the foregoing reasons and in view of the above clarifying amendments, Applicant respectfully requests the Examiner to reconsider

and withdraw all of the objections and rejections of record, and earnestly solicits an early issuance of a Notice of Allowance.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Figures 2-9
Terminal Disclaimer